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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/501,793	02/10/2000	Rob G. Parrish	1475-00200	4384

7590 10/21/2003
Jonathan Pierce Conley & Tayon
600 Travis, Suite 1800
Houston, TX 77002

EXAMINER

FISCHER, ANDREW J

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 10/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/501,793

Applicant(s)

PARRISH, ROB G.

Examiner

Andrew J. Fischer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 13 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 59-74 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 59-74 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 February 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination ("RCE") under 37 C.F.R. §1.114, including the fee set forth in 37 C.F.R. §1.17(e), was filed in this application after final rejection on June 13, 2003 (Paper No. 24). Since this application is eligible for continued examination under 37 C.F.R. §1.114, and the fee set forth in 37 C.F.R. §1.17(e) has been timely paid, the finality of the previous Office Action (Paper No. 19) has been withdrawn pursuant to 37 C.F.R. §1.114.

Acknowledgments

2. The Petition to Revive this application under 37 C.F.R. §1.137(b) was received on June 13, 2003 (Paper No. 22). The petition to revive has been granted (Paper No. 27).
3. The Power to inspect filed July 1, 2003 (Paper No. 21) is acknowledged. The revocation and power of attorney filed June 13, 2003 (Paper No. 25) is also acknowledged.
4. The amendment filed June 13, 2003 (Paper No. 23) is acknowledged. Accordingly, claims 59-74 remain pending.

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Specification

5. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

- a. The “mount” as recited in claim 73.

Drawings

6. The drawings are objected to under 37 C.F.R. §1.83(a). The drawings must show every feature of the invention specified in the claims. No new matter allowed. The following must be shown or the features canceled from the claims:

- a. The “first end” and the “second end” of the receptacle as claimed in both 59 and 63.
- b. The “temporary storage device mounted on a wall” as recited in claim 62.
- c. The “mounting portion receptacle having first and second ends” as recited in claim 68. Although the “mounting portion receptacle” is shown in the drawings, as 22 in *e.g.* Figure 2, the first and second ends are not shown.
- d. The “mount disposed on said first end” as recited in figure 73.

7. A proposed drawing correction or corrected drawings are required in reply to this Office action to avoid abandonment of the application. The objections to the drawings will not be held in abeyance.

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8. The proposed drawing correction filed on May 24, 2003 (Paper No. 15) drawn to Figures 15 and 16 have been disapproved by the Examiner because they introduce new matter into the drawings. 37 C.F.R. §1.121(a)(6) states that no amendment may introduce new matter into the disclosure of an application. The original disclosure does not support the showing of how the structure attaches to what may appear to be the ground.

9. The proposed drawing correction filed on May 24, 2003 (Paper No. 15) drawn to Figures 6a and 6b have also been disapproved by the Examiner because it does not show changes in red ink or with the changes otherwise highlighted. See MPEP § 608.02(v).

Claim Rejections - 35 USC § 112 1st Paragraph

10. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

-Written Description

11. Claims 59-72 are rejected under 35 U.S.C. §112, 1st paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

a. First, “a wall of immovable structure” as recited in claims 59 and 68 is considered new matter. If Applicant can expressly point out where in the *original specification* the

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description is found, this particular 35 U.S.C. §112, 1st paragraph rejection will be withdrawn. The Examiner notes the specification provides disclosure for a “retaining structure” but not “a wall of immovable structure.” Although “a wall of immovable structure” is at best obvious in view of the original disclosure, “a wall of immovable structure” is nevertheless not disclosed.

b. In claim 63, The “temporary storage device mounted on a wall” is new matter. As noted above, Applicant has does not have support for a wall, only a “retaining structure.” If Applicant can expressly point out where in the *original specification* “the temporary storage device mounted on a wall” is found, this particular 35 U.S.C. §112, 1st paragraph rejection will be withdrawn.

-Enablement

12. Claims 59-67 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

a. In claim 59, it is unclear what is the first end of the receptacle and the second end of the receptacle. Applicant claims “a mount is disposed on the first end of said receptacle” However Applicant also claims the “second end of said receptacle extending into the wall.” Thus, according to claim 59, the mount and wall are on *opposite ends* of the receptacle. This does not make sense. Which end therefore is the receptacle “capable of coupling to the trailer

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hitch apparatus?” It is the Examiner position that claim 59 attempts an inoperable or impossible limitation. “A claimed invention having an inoperable or impossible claim limitation may lack utility under 35 U.S.C. §101 and certainly lacks an enabling disclosure under 35 U.S.C. §112.”

EMI Group North America, Inc. v. Cypress Semiconductor Corp., 268 F.3d 1342, 60 USPQ2d 1423, 1427 (Fed. Cir. 2001) (citations omitted).

b. In claim 63, it is unclear how the first end is substantially flat with the wall and the second end extends into the wall. This would make the receptacle at most no longer than the width of the wall. Again, this is an impossible limitation. See *EMI Group*.

Claim Rejections - 35 USC § 112 2nd Paragraph

13. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the Applicant regards as his invention.

14. Claims 59-67 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The claims are replete with errors. Some examples follow.

a. In claim 59, it is unclear what is the first and second ends of the receptacle.

b. In claim 63, it is unclear whether the applicant is claiming the subcombination of an apparatus or the combination of an apparatus and a wall since Applicant recites “said first end is substantially flat with said wall”

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If Applicant's intent is to claim only the subcombination, the body of the claim(s) must be amended to remove any positive recitation of the combination (i.e. the wall). If Applicant intends to claim the combination, the preamble of the claim must be amended to be consistent with the language in the body of the claim. In the case of the later, the Examiner suggests a system.

It is the Examiner's position that the limitations "capable of being extended into the wall" are functional limitations which are given little patentable weight thereby placing any such positive structural limitations found within this phrase to be outside the claim's scope. In addition to the above, if Applicant concurs with the Examiner's position, the Examiner respectfully requests Applicant to explicitly state their concurrence on the record. Upon receiving such concurrence, the 35 U.S.C. §112 2nd paragraph rejection will then be withdrawn. Alternatively, if Applicant argues that the limitation should be given greater patentable weight requiring the Examiner to show the prior art having such structural features, the 35 U.S.C. §112 2nd paragraph rejection will be maintained.

c. Also in claim 63, it is unclear how the first end is substantially flat with the wall and the second end extends into the wall. This would make the receptacle at most, no longer than the width of the wall.

d. In claims 69 and 70, it is unclear what is a mounting portion since the drawings show the mounting portion as a rectangular member.

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Claim Rejections - 35 USC § 102

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. . . .

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

16. Claims 59-72, as understood by the Examiner, are rejected under 35 U.S.C. 102(b) as being anticipated by Taylor (U.S. 4,546,994). Taylor discloses a retaining structure (21); a mounting portion receptacle (22) having first and second ends; a mounting portion.

17. Claims 68-72, as understood by the Examiner, are alternatively rejected under 35 U.S.C. 102(b) as being anticipated by Helber (U.S. 5,149,122). Helber discloses a retaining structure (70); a mounting portion having an opening (72); and a mounting portion receptacle (68).

Claim Rejections - 35 USC § 103

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claims 73 and 74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Howell (U.S. 6,170,723) in view of Klemeten (U.S. 5,476,279). Howell discloses a vehicle storage compartment. Howell does not directly disclose a mount and receptacle. Klemeten teaches a receptacle (end of 2) for storing a hitch 5 when not in use so that the hitch does rattle or get lost. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Howell as taught by Klemeten to include a mount and receptacle to hold the hitch when not in use so it doesn't rattle or get lost.

20. The Examiner concludes that Applicant has decided not to be his own lexicographer by indicating and defining claim limitations to have meanings other than their ordinary and accustomed meanings. To support this position, the Examiner relies on the following factual findings. First and as noted in the previous Office Action,¹ the Examiner has carefully reviewed the specification and prosecution history and can not locate any lexicographic definition(s). Second, the Examiner finds that not only has Applicant not pointed to definitional statements in his specification or prosecution history, Applicant has also not pointed to a term or terms in a claim with which to

¹ See the Examiner's previous Office Action mailed July 24, 2002, Paper No. 19, Paragraph No. 16.

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draw in those statements.² Third, after receiving express notice in the previous Office Action³ of the Examiner's position that lexicography is *not* invoked, Applicant has not pointed out the "supposed errors" in the Examiner's position regarding lexicography invocation in accordance with 37 C.F.R. §1.111(b) (i.e. Applicant has not argued lexicography *is* invoked). Finally and to be sure of Applicant's intent, the Examiner also notes that Applicant has declined the Examiner's express invitation⁴ to be his own lexicographer.⁵ Accordingly and for due process purposes, the Examiner gives notice that for the remainder of the examination process and unless expressly noted otherwise by the Examiner, the heavy presumption in favor of the ordinary and accustomed meaning is not overcome; the claims therefore continue to be interpreted with their "broadest reasonable interpretation" *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027

² "In order to overcome this heavy presumption in favor of the ordinary meaning of claim language, it is clear that a party wishing to use statements in the written description to confine or otherwise affect a patent's scope must, at the very least, point to a term or terms in the claim with which to draw in those statements." *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999).

³ See again the Examiner's previous Office Action, Paper No. 19, Paragraph No. 16.

⁴ *Id.*

⁵ The Examiner's requirements on this matter were reasonable on at least two separate and independent grounds. First, the Examiner's requirements were simply an express request for clarification of how Applicant intend his claims to be interpreted so that lexicography (or even an *attempt* at lexicography) by Applicant was not inadvertently overlooked by the Examiner. Second, the requirements were reasonable in view of the USPTO's goals of compact prosecution, productivity with particular emphasis on reductions in both pendency and cycle time, and other goals as outlined in the USPTO's The 21st Century Strategic Plan, February 3, 2003 available at www.uspto.gov/web/offices/com/strat21/index.htm (last accessed September 27, 2003).

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(Fed. Cir. 1997).⁶ The Examiner now relies heavily and extensively on this interpretation.⁷

Unless expressly noted otherwise by the Examiner, the preceding claim interpretation principles in this paragraph apply to all examined claims currently pending.

Response to Arguments

21. Applicant's arguments with respect to the claims have been considered but are moot in view of the new grounds of rejection.

22. Regarding the 35 U.S.C. §112, 1st paragraph rejections, they are maintained. Applicant argues that "as previously shown, the specification provides support for 'a wall of immovable structure.'" The Examiner has again reviewed Applicant's previous responses. Specifically, the Examiner has reviewed Applicant's "Remarks" accompanying Amendment 'D' filed June 5, 2002 (Paper No. 18) and discussion is not found. The Examiner notes the "Proposed Drawing Amendment" filed May 24, 2002 (Paper No. 15) but they have not been entered. Likewise, the Examiner has reviewed the substitute specification also filed May 24, 2002 (Paper No. 17) but that too has not been entered. So again, the 35 U.S.C. §112, 1st paragraph rejections remain. The

⁶ See also *In re Bass*, 314 F.3d 575, 577, 65 USPQ2d 1156, 1158 (Fed. Cir. 2002) ("In examining a patent claim, the PTO must apply the broadest reasonable meaning to the claim language, taking into account any definitions presented in the specification. Words in a claim are to be given their ordinary and accustomed meaning unless the inventor chose to be his own lexicographer in the specification."); MPEP §§ 2111 and 2111.01; and *In re Etter*, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985) (en banc).

⁷ See 37 C.F.R. §1.104(c)(3) which states in part: "the examiner may rely upon admissions by applicant . . . as to *any matter* affecting patentability [Emphasis added.]"

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Examiner admits that Applicant has support for a “retaining structure” (101) as shown in Figure 12 but a “retaining structure” is not an immovable wall.

23. It is the Examiner position that because Applicant has claimed “an apparatus” in claims 59, 63, 68, and 73, the “trailer hitch apparatus” is not part of the claimed invention.

24. The Examiner maintains and concurs with Applicant’s position that the inventions are not patentably distinct. See Applicant’s response, January 22, 2001 (Paper No. 4), page 3 where Applicant states “Because the inventions are not patentably distinct, Applicant contends the restriction requirement is improper.” The Examiner continues to rely on this statement.

25. Since Applicant did not seasonably traverse the Official Notice statement(s) as stated in Paper No. 7, paragraph No. 12, the well known statement(s) are taken to be admitted prior art. See MPEP §2144.03 and *In re Chevenard*, 139 F.2d 71, 60 USPQ 239 (CCPA 1943).

26. The “means for” phrases have been interpreted as set forth in the *Supplemental Examination Guidelines for Determining the Applicability of 35 USC 112 6[¶]8* and MPEP §2181.

Conclusion

27. The following two (2) citations to the Manual of Patent Examining Procedure (“MPEP”) apply to this Office Action: MPEP citations to Chapters 200, 700, 1800, and 2100 are from the MPEP 8th Edition, Rev 1, February 2003. All remaining MPEP citations are from MPEP 8th Edition, August 2001.

⁸ Federal Register Vol 65, No 120, June 21, 2000.

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28. Suggestions or examples of claim language provided by the Examiner in this Office Action are just that—suggestions or examples—and do not constitute a formal requirement mandated by the Examiner. Unless stated otherwise by an express indication that the claim is “allowed,” exemplary claim language provided by the Examiner to overcome a particular rejection or to change claim interpretation has *not been addressed* with respect to other aspects of patentability (e.g. §101 patentable subject matter, §112 1st paragraph written description and enablement, §112 2nd paragraph indefiniteness, and §102 and §103 prior art). Therefore, any claim amendment that incorporates an Examiner suggestion or example or simply changes claim interpretation will still require further consideration and/or search and a patentability determination as noted above.

29. In accordance with the USPTO’s goals of customer service, compact prosecution, and reduction of cycle time, the Examiner has made every effort to clarify his position regarding claim interpretation and any rejections or objections in this application. Furthermore, the Examiner has provided Applicant with notice—for due process purposes—of his position regarding his factual determinations and legal conclusions. If Applicant disagrees with *any* factual determination or legal conclusion made by the Examiner in this Office Action whether expressly stated or implied,⁹ the Examiner respectfully reminds Applicant to properly traverse the Examiner’s position(s) in accordance with 37 C.F.R. §1.111(b) *in his next response*. By addressing these issues now, matters where the Examiner and Applicant agree can be eliminated allowing the Examiner and

⁹ E.g., if the Examiner rejected a claim under §103 with two references, although not directly stated, it is the Examiner’s implied position that the references are analogous art.

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Applicant to focus on areas of disagreement (if any) with the goal towards allowance in the shortest possible time. If Applicant has any questions regarding the Examiner's positions or has other questions regarding this communication or even previous communications, Applicant is strongly encouraged to contact Examiner Andrew J. Fischer whose telephone number is (703) 305-0292. If attempts to reach the Examiner by telephone are unsuccessful, the examiner's immediate supervisor, Robert Olszewski, can be reached at (703) 308-5183. To respond to this Office Action by facsimile, fax to (703) 872-9306.



Andrew J. Fischer
Patent Examiner

AJF
October 18, 2003